

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Christine Wild, et al.

Examiner: **Hasan S. Ahmed**

Application No.:

**App. No. 10/517,733
(Conf. No. 6029)**

Group Art Unit: **1618**

Filed: **June 30, 2005**

Attorney Docket No. **C 2507 PCT/US**
(S&L Docket No. P40028 USA)

For: **Lotions for Nonwovens**

FILED ELECTRONICALLY ON AUGUST 18, 2008

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO THE MARCH 18, 2008 OFFICE ACTION

Sir:

The Examiner rejected the pending claims 16-20, 22-28 and 30-35 for obviousness in light of Tyrrell (U.S. Patent No. 6,749,860) either alone, or in the cases of certain of those claims, further in view of Hisanaka (U.S. Patent Publication 2002/005816). Because Tyrrell is so defective as a reference on which to found an obviousness rejection, we request that the Examiner withdraw the obviousness rejection and allow this case.

As to the obviousness-type double patenting rejection is concerned, as U.S. Patent Application No. 11/458,651 is still under prosecution, we cannot yet ascertain whether the inventions in the claims that might be allowed in that case might be "obvious" in relation to claims pending in this case. As such, it is premature for us to consider

whether to submit a terminal disclaimer or not. Accordingly, we request that the Examiner withdraw that rejection and re-consider it later at such time that claims might be allowed in that application.

As to Tyrell, its specification spans an incredible 56 columns. From that voluminous disclosure, the Examiner extracts various things that Tyrell says are optional, including optional members of optional Markush groups. Then the Examiner takes those very selective elements from Tyrell and combines them together in ways Tyrell didn't disclose. The rejection is topped off by the Examiner asserting that the amounts and the melting points set forth in the claims but not disclosed by Tyrell are simply a matter of "routine or manipulative experimentation." There is absolutely no evidence of record or in the art cited by the Examiner that those amounts and melting points are simply a matter of "routine or manipulative experimentation" (whatever that might mean).

To illustrate how the Examiner very selectively extracts things from Tyrell, he states that on Tyrell's col. 5, lines 30-48 Tyrell discloses "synthetic waxes" per element (a) of claim 16. There's no synthetic wax in that part of Tyrell. To be fair to the Examiner, Tyrell in that same section lists "fatty alcohols" that are also mentioned in claim 16, part (a). However, Tyrell lists "fatty alcohols" as one of at least 27 different types of optional emollients. So in this regard as in others, the Examiner selected one optional member of a group of optional additives in Tyrell.

Similarly, the Examiner skips two columns ahead from column 5 to column 7 of Tyrell to find an "alkoxylated derivative of fatty acid esters" in Tyrell as set forth in claim 16, part (b). But again, Tyrell states that one such ester is one of at least 24 types of optional viscosity enhancers that are not such an ester.

Skipping ahead five more columns to column 12 of Tyrell, the Examiner picks out a polymeric wax from Tyrell from a list of at least 24 optional solidifying agents.

Selecting members from long lists of optional ingredients from Tyrell is clearly a case of impermissible picking and choosing and hindsight reconstruction. No obviousness rejection can be based on this. This is particularly so in light of the fact that Tyrell doesn't disclose the amounts or the melting points set forth in claim 16 and its dependents. Saying that without any supporting evidence that all of this is simply "routine" is an inappropriate way to reject claims.

To reject dependent claims, the Examiner reaches yet deeper into Tyrell at columns 28, 29 and 51 (in relation to claims 25, 26, 27 and 35). Then without anything suggesting combining Tyrell with Hisanaka, picks Hisanaka out of many other references in this field to reject claims 18-20, 28, 31 and 32. While we are reminded by the Supreme Court that we should not rigidly apply the "teaching, suggestion, motivation" ("TSM") test for obviousness, that same court ruled that we cannot reject the TSM test as it remains one way to assess whether two references are in fact combinable. So we ask here, where is a TSM either to pick and choose from Tyrell or to combine the selective disclosures from Tyrell with equally selective disclosures from Hisanaka to yield Applicants' invention? We don't see any TSM here.

These rejections should be withdrawn and the case allowed.